REMARKS

In the Office Action mailed March 17, 2003 the Examiner noted that claims 1-37 were pending, objected to claims 6-8 and 10-37 and rejected claims 1-5 and 9. New claims 38-40 have been added and, thus, in view of the forgoing claims 1-40 remain pending for reconsideration which is requested. No new matter has been added. The Examiner's rejections and U.S Patent and Trademark Office objections are traversed below.

Included with the Action was a Notice Of Draftspersons Patent Drawing Review objecting to the drawings, indicating that lines and numbers in figures 10-22 were not uniformly thick, etc. and noting that the Examiner would require new drawings when necessary. The Examiner has not required such new drawings. These figures are image or picture type examples where the figures are conveying the state of images. As a result, it is submitted that no new drawings should be required, apparently as recognized by the Examiner.

In the Office Action the Examiner objected to claims 6-8 and 10-37 and indicated that these claims would be allowable if rewritten in independent form. It is submitted that these claims are still allowable.

On page 2 of the Office Action the Examiner rejected claims 1-5 and 9 under 35 U.S.C. § 102 as anticipated by '362 to Ostromoukhov.

As a part of the basis for the rejection the Examiner asserts:

The pixel having a plotting area and background area are inherent in that it depends on the type of color image being input to the system. Assuming a color magazine, for example, the plotting area, which is the textual area or the image area exist on the magazine and will have a pixel of one type of binary representation. The background of the magazine, assuming that it could be essentially white, will have a pixel representing another type of binary representation. Hence, any image input to the system will inherently have background information and plotter information and each will be represented in terms of a pixel representation.

(see Action page 3).

The Examiner is apparently basing this assertion on personal knowledge. The Examiner is requested to support this personal knowledge with an affidavit or reference as called for in 37 CFR section 1.104(d)(2) or withdraw the rejection.

Inherency requires that the reference make clear that the missing material is necessarily present in the reference:

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[T]he examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See Ex parte Levy, 17 USPQ 2d 1461, 1464 (B.P.A.I. 1990).

If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." . . . "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." See In re Robertson, 49 USPQ 2d 1949, 1950-51 (Fed. Cir. 1999) (quoting Continental Can Co. v. Monsanto Co., 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991)).

Something is not necessarily present in a reference if the reference teaches away from the thing being asserted as being inherent. This is the case for '362. The Examiner asserts that a magazine inherently has images where the background area and a plotter area are represented in the pixel data. Color images in a magazine are halftone images. With respect to halftone images, '362 particularly states:

More particularly, for each pixel of an image on monitor 23, color management system 34 converts the gray-level RGB value of the pixel into a binary halftone value for each of the CMYK color components printed by printer 30. For example, if each pixel of the image on monitor 23 is represented by a 24-bit RGB value (i.e., eight bits for R, eight bits for G, and eight bits for B), color management system 34 obtains a digital halftone value in which each of the CMYK color components is represented by a single bit indicating whether a dot of the respective color component is to be printed at a corresponding pixel position by printer 30.

(see '362 col. 6, lines 56-67).

As can be seen from the above description, a halftone image is an image in which each bit represents the on/off of a color at that particular location in the image. Thus, information about background versus plotting areas is not present in magazine images according to '362. Thus, such does not necessarily flow from '362 and is therefore not inherent.

A halftone image as in '362 does not have pixels where "each pixel has a value representing either a background area or a plotting area in the gray scale image" (see claims 1, 2 and 3).

In contrast, the present invention is directed to a system that will take a color image and convert it to a gray scale image (see claim 3), and it will convert the gray scale image into a

specialized binary image where the pixels of the image represent either background areas or plotted areas (see claims 1, 2 and 3). The present invention can start with the gray scale color image discussed in '362 at col. 6, lines 56 and 57 particularly noted by the Examiner and obtain the specialized image of the present invention where pixels indicate the type of area. The present invention is capable of distinguishing background and plotting areas of images in situations where the prior art is not and solves a problem not even contemplated by '362.

For the above discussed reasons, it is requested that the rejection be withdrawn.

The dependent claims 3-5 and 9 depend from the above-discussed independent claims and are patentable over the prior art for the reasons discussed above. The dependent claims also recite additional features not taught or suggested by the prior art. For example, claim 5 calls for partial extraction and partial coding and then combining of the partially coded images. Nothing in '362 addresses this. It is submitted that the dependent claims are independently patentable over the prior art.

New claims 38-40 also emphasize the features of the present invention discussed above. Nothing in the prior art teaches or suggests such. It is submitted that these new claims distinguish over the prior art.

It is submitted that the claims are not taught, disclosed or suggested by the prior art. The claims are therefore in a condition suitable for allowance. An early Notice of Allowance is requested.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: ___7/17/3___   By: _____

J. Randall Beckers
Registration No. 30,358

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501